



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/060,047	04/14/98	DUNN	R 8905.157US01

HM12/0818
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, PA
P.O. BOX 2938
MINNEAPOLIS MN 55402

EXAMINER

WEBMAN, E

ART UNIT

PAPER NUMBER

1617

13

DATE MAILED:

08/18/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/060047

Applicant(s)

DUNN

Examiner

WGBMAN

Group Art Unit

1617

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 5/8/00
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-28 is/are pending in the application.
- Of the above claim(s) 25, 26 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-24, 27, 28 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Applicable Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 12
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit: 1617

Applicant's election of Group I in Paper No. 6 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The applicant states on the record in paper # 11, Filed 5/8/00, that aqueous and non-aqueous carriers are equivalent and that polymeric and non-polymeric matrices are equivalent.^{ent} Further, applicants state on the record that the species of carriers and matrices are not patentably distinct. Thus, the election of species requirements are withdrawn.

However, if the examiner finds one of the inventions unpatentable [†]~~of~~ over the prior ~~are~~, the above admission may be used in a rejection under 35 USC 103 (a) of the other inventions.

Claims 6,17,18 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 6 "Low - Melting." is vague; "low" is subjective. Similarly, in claims 17 and 18 respectively, "high" and "Low" are vague.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-24, 27, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 95/27481.

Art Unit: 1617

'481 teaches incorporating an active agent into a controlled release component and combining that component with a liquid polymer system (page 4 lines 26-34). An emulsion formed by addition of an aqueous carrier containing an active agent to a liquid prepolymer is disclosed (page 12 line 29, page 13, line 9). Suitable polymers (page 21 lines 21-35), Solvents (page 22-23) and active agents (pages 25-28) are disclosed. The aqueous carrier comprises the active agent dispersed in a Liposphere comprising wax (page 12 lines 29-37).

It would have been obvious to one of ordinary skill to deliver an active in an emulsion of an aqueous controlled release component added to a liquid pre-polymer in view of '481. As to the claimed aqueous and non-aqueous carriers, polymeric and non-polymeric matrices, and the particular carried species Thereof, applicants have admitted on the record that the carriers and matrices are not patentably distinct.

No claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward J. Wedman whose telephone number is (703) -308-4432. The examiner can normally be reached on Monday through Friday from 9 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, M. Moezie, can be reached on (703) -308-0570. The fax phone number for the organization where this application or proceeding is assigned is (703) -305-3592.

Application/Control Number: 09/060047

Page 4

Art Unit: 1617

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) -308-1235.

Webman/LR

August 3, 2000

1
EDWARD J. WEBMAN
PRIMARY EXAMINER
GROUP 1500